UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,223	09/28/2001	James B. Kargman	P06,0189-02	5896

26574   7590   06/23/2009
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ART UNIT	PAPER NUMBER
3685	

MAIL DATE	DELIVERY MODE
06/23/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 March 2009</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-43</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-43</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Acknowledgements

The Applicants amendment filed on March 26, 2009 is hereby acknowledged, Claims 1-43 remain pending.

Response to Arguments

1. Applicant's arguments, with respect to the rejection(s) of claim(s) 1-43 have been fully considered. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-43 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

3. To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

4. In this particular case, claim 1 fails prong (1) <u>because the "tie" (e.g. wireless network) is representative of extra-solution activity</u>. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

5. Claims 2-43 are either dependant upon the above rejected claims or contain similar limitations and are rejected for at least the same reason.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Movalli et al (U.S. PG Pub No. 2005/0004876A1) ("Movalli") in view of Joao et al. (U.S. PG Pub No.

2001/0051920) ("Joao") and further in view of Teper et al. (U.S. Patent

5,815,665)("Teper").

7. As per claim 1,3 and 4,

Movalli teaches a method of electronically executing a commercial transaction between a

remotely located customer and a vendor, the method comprising the steps of:

transmitting electronically a_ vendor identity code from the vendor to a wireless

communication device of a customer, the wireless communication device being capable of

operation on a wireless communication network; authenticating the transaction code using

the authentication data; executing the identified commercial transaction by the vendor (see

figs 4, 5, paragraphs 0046-0051)

Movalli fails to teach the claimed feature of transmitting electronically the transaction

code from the wireless communication device of the customer to an electronic order

processing system associated with the vendor based on the vendor identity code; receiving

the transaction code by the order processing system associated with the vendor; identifying

the customer user based upon the customer identification contents of the transaction code;

identifying a commercial transaction using the transaction identification data associated

with the transaction code; Teper teaches transmitting electronically the transaction code

from the wireless communication device of the customer to an electronic order processing

system associated with the vendor based on the vendor identity code; receiving the

transaction code by the order processing system associated with the vendor; identifying the

customer user based upon the customer identification contents of the transaction code;

identifying a commercial transaction using the transaction identification data associated

with the transaction code; (column 8, line 55, data stored by the Online broker site

includes at least "unique ID and billing history, it is obvious that items in a database would

share a common key, customer ID in the present case). Therefore it would have been

obvious to one of ordinary skill in the art at the time the invention was made to modify

Movalli et al's disclosure to include Teper teaching of authentication process because this

would allow an anonymous user to be securely authenticated without compromising the

users identity; furthermore the combination of these elements does not alter their

respective functions, and the combination would have yielded predictable results to one of

ordinary skill in the art at the time of the invention.

Movalli fails to teach the claimed feature of storing the vendor identity code and

a transaction code in a memory of the wireless communication device of the customer, the

vendor identity code including one of a telephone dialing sequence and a network address

and a text message, the transaction code including a customer identification, authentication

data, and transaction identification data; Joao discloses storing the vendor identity code

and a transaction code in a memory of the wireless communication device of the customer,

the vendor identity code including one of a telephone dialing sequence and a network

address and a text message, the transaction code including a customer identification,

authentication data, and transaction identification data; (Paragraphs 34 and 35 – name of

the store is a "text message" – Examiner notes stored data is not functionally related to

the memory in which it is stored it does not distinguish the claimed apparatus, method, and

system from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70

USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP

2106.01)). Therefore it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify Movalli et al's disclosure to include Joao's

teaching of authentication process because this would allow an anonymous user to be

securely authenticated without compromising the users identity; furthermore the

combination of these elements does not alter their respective functions, and the

combination would have yielded predictable results to one of ordinary skill in the art at the

time of the invention.

8. As per claim 2 and 20,

    Movalli teaches a method where the transaction code is comprised of a telephone dialing

    sequence, and applying the transaction code dial sequence to a line associated with a

    public switched telephone network (see figs 1).

9. As per claim 3 and 21,

10. Movalli teaches the limitations of claim 1, and additionally; a method in which the

    transaction code is comprised of a Universal Resource Locator, and the transaction code is

    transmitted via the Internet (see fig 1, 2, 3).

11. As per claim 4 and 19,

     Movalli teaches the limitations of claim 1, and additionally; a method of transmitting a

    transaction code that has been previously stored within digital memory associated with a

    wireless telephone via a wireless communications network (see fig 1).

12. As per claim 5,

Movalli teaches a method Of identifying the contents of a user

identification data field within the transaction code; locating the user identification data

field contents within a database accessible by the order processing system (see paragraphs

0046- 0051).

13. As per claim 6,

Movalli teaches a method ofidentifying the contents of a security code field within the

transaction code; determining that the received transaction code is authentic when the

contents of the security code field correspond to a previously-configured security code

associated with the contents of the user identification data field, which previously-

configured security code is stored within a database accessible by the order processing

system (see paragraphs 0046-0051).

14. As per claim 7,

Movalli teaches a method of identifying a decryption key associated

with the contents of the user identification data field; decrypting at least a portion of the

transaction code using the identified decryption key; determining whether the decrypted

portion of the transaction code is valid (see paragraphs 0046-0051).

15. As per claim 8, Movalli teaches a method of identifying a decryption key based upon the

identity of the user; decrypting at least a portion of the transaction code using the

decryption key (see paragraphs 0054).

16. As per claim 9, Movalli teaches a method of determining the contents of a transaction

identification field within the transaction code; locating the contents of the transaction

identification field within a database accessible by the order processing system; identifying

the nature of the commercial transaction based upon information within the database

associated with the contents of the transaction identification field(see paragraphs 0046-

0051).

17. As per claim 10, Movalli teaches a method of determining the contents of a transaction

identification field within the transaction code; identifying the nature of the commercial

transaction based upon information within the transaction identification field (see

paragraphs 0046-0051)

18. As per claim 11, Movalli teaches a method of locating a record within a database

associated with the order processing system based upon the identity of the user; retrieving

details of the commercial transaction from the database record associated with the user

(see paragraphs 0046-0051).

19. As per claim 12,

Movalli teaches a method maintained within a point of sale computer system operated by

the vendor (see fig 1, 2).

20. As per claim 13,

21. Movalli teaches a method of entering the identified commercial transaction into a point of

sale computer system operated by the vendor (see fig 1).

22. As per claim 40
Movalli teaches a method as claimed in claim 1,
Official Notice is taken that "commercial transaction is a food order and wherein said step
of executing the identified commercial transaction includes preparing food items for
consumption according to the food order" is common and well known in prior art in
reference to commercial transactions. It would have been obvious to one having ordinary
skill in the art at the time the invention was made to prepare food in response to an order
because thi9s allows the merchant to make a profit.

23. Claims 14-39 and 41-43 are in parallel with claims 1-13 and are rejected for at least the

same reasons.

Conclusion

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office

action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

25. A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than

SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-

6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have

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(EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer

Service Representative or access to the automated information system, call 800-786-9199

(IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685